

## REMARKS

Reconsideration of this application as amended is respectfully requested.

In the Office Action, claims 128-141 and 147-149 are pending and rejected.

In this response, no claim has been canceled. Claims 128, 136, 139 and 148 have been amended and no new claim has been added. Thus, claims 128-141 and 147-149 remain pending.

### Claim Rejections under §112

Applicant submits that the presently amended claims overcome the various rejections under 35 U.S.C. §112.

With respect to the rejection that claim 128 included material not present in the specification, Applicant respectfully insists that claim 128, as amended by the amendment dated August 22, 2007, was fully supported by the specification which included Figures 4B and 10 and paragraphs 59-60, 81 and 86. Even if the words “recess” or “recessed” or “below” are not in the text of the specification, the figures (e.g. Figure 4B and Figure 10) along with the accompanying text clearly show a void recessed below the outer spherical surface of a spherical material.

Paragraph 86 states the following:

**Figure 10** shows an example of a manufacturing technique for forming voids for electrical components and also for forming depression troughs on the core which can be used to form a template or create a template for the antenna pattern. The core 403 is shown after the mold 401 and 402 has formed the voids 404A and 404B and the depression troughs 406A and 406B. The core 403 may be formed in the manner described above in which an unvulcanized rubber composition is placed within the mold and compressed under high pressure and with high temperature in the manner described above to form the vulcanized core 403. The mold 401 and 402 includes protrusions 403A and 403B which form the voids 404A and 404B. Similarly, the mold 401 and 402 includes protrusions 405A and 405B which cause the formation of the troughs 406A and 406B, thereby creating a template for the formation of the antenna pattern. It will be appreciated that **Figure 10** is a cross-sectional view of the mold with the core within the mold after the core has been molded.

Looking first at Figure 10, the core 403 is “a spherical material having an outer spherical surface” (claim 128), and there are two voids (404A and 404B) formed in the spherical material by the mold 401 and 402. These voids are, as shown in Figure 10 and Figure 4B, recessed below the outer spherical surface. Figure 10 also shows how the voids are created at the first pole and the second pole of an axis. Specifically, the protrusions 403A and 403B in the molds 401 and 402 form the voids during the molding process so that the outer spherical surface includes two voids which are recessed below that surface. A protrusion in the mold will cause the base of the void, which the protrusion forms, to be below the spherical surface of the core 403. In other words, the protrusion in the mold inherently requires the base of the void to be recessed below the outer spherical surface of the core which is formed by the mold. These voids, as explained in paragraph 81, are for receiving the electrical components. Figure 4B, as explained in paragraphs 59-60, shows, in a cross-sectional view, an enlarged view of the portion of core 82 around the void 83. Figure 4B shows that the electrical component 84 has a first surface (the “bottom” surface of component 84) which is disposed adjacent to the base of the first void and which is coupled to the base by the adhesive material, and Figure 4B also shows that the electrical component 84 has a second surface (the “upper” surface which faces outwardly from the core 82) which is parallel with the first surface. This second surface of the electrical component 84 is adjacent to the outer surface of the spherical material at the upper end of the void which is also adjacent to the outer surface. In this sense, the second surface of the electrical component 84 is substantially flush with the outer surface of the spherical material.

The Office Action also included a rejection of claim 128 “under 35 U.S.C. §112 for enablement” and the Examiner, in connection with this rejection, suggested adding the material of claim 130 into claim 128. Claim 128 is directed to an aspect of Applicant’s invention--the core or other spherical object which will become a golf ball and which includes the voids

designed to receive one or more electrical components as part of a completed golf ball.

Applicant is entitled to claim separately the various parts of the disclosed invention. Just as it is acceptable to claim only a client portion of a client/server networked computer system, it is acceptable to claim a portion of an unfinished golf ball. Figure 10 and the accompanying description, as well as other paragraphs of the specification, clearly have provided an enabling disclosure of this aspect of Applicant's invention. Hence, claim 128 is not overly broad and the specification provides an enabling disclosure.

Claim 139 was rejected under 35 U.S.C. §112(2) as being indefinite. In response, Applicant has amended claim 139; these amendments are supported by the specification, including, for example, paragraph 78. Hence, the rejection of claim 139 should be withdrawn.

#### *Claim Rejections under §103*

Claims 136-138, 140-141 and 147-149 were rejected as being unpatentable over Little (US 5,626,531) in view of Horchler (US 3,782,730). Applicant submits that these claims are not obvious or unpatentable over Little in view of Horchler. Little describes a golf ball with a single void which extends into the center of the ball. Compensatory plugs 22 surround an electronic transducer tag 20 within the single void of Little, and a filler plug 18 is placed at the upper end of the single void, and the upper surface of the filler plug 18 appears to be flush with the outer surface of the core portion 14. Horchler describes an active electronic circuit at the center of the ball; Horchler does not describe a void on an outer surface of a spherical material, and Horchler does not describe the use of adhesive between an electrical component and a base of a void.

Applicant submits that the combination of Little and Horchler fails to describe at least two limitations in the independent claims 136 and 148; specifically, these references fail to describe an adhesive material between the spherical material at a base of the first void and an

electrical component, and these references also fail to describe the electrical component which has a second surface which is adjacent to the outer surface of the spherical material at an upper end of the void which is adjacent to the outer surface. Little does not need an adhesive material as claimed because of the filler plug 18 and the cover portion 12 which serve to secure the tag 20 in Little's design. The compensatory plugs 22 are not adhesive materials and there is no need for such materials for the reason just given. Horchler also does not describe such an adhesive material. The Examiner asserted that one of ordinary skill in the art would recognize that an adhesive is equivalent to the "force fit" disclosed by Little. It is respectfully submitted that, in the context of the design of a golf ball based upon Little, such equivalence would not be recognized because there is no need for an adhesive. The filler plug 18 and the outer layer 12 effectively lock the tag 20 within the single void of Little, and this locking arrangement makes an adhesive unnecessary. Further, the force fitting of the tag 20 also makes one of ordinary skill in the art to recognize that an adhesive, situated between the spherical material at a base of a void and the electrical component, is not necessary. Hence, this claimed adhesive feature is not disclosed in either reference and is not obvious in view of the references.

Claims 136 and 148 also include another limitation which is not present in the combination of Little and Horchler; in particular, the limitation that the electrical component have a second surface which is adjacent to the outer surface of the spherical material at an upper end of the void, which upper end is adjacent to the outer surface. In effect, the electrical component completes a section of the outer surface. This feature can be seen in Figure 4B, which shows how the upper surface of the electrical component is adjacent to the outer surface of the spherical material and, in effect, completes a section of the outer surface. Little's design requires that the tag 20 be centered within the single void of Little and further requires a filler plug 18 near the outer surface of the core portion 14. Hence, the subject claim limitation is not

disclosed in either Little or Horchler and is not obvious in view of these references. Thus, claims 136-141 and 147-149 should be allowed. The dependent claims 137-141, 147 and 149 add further limitations not taught by these references and hence should also be allowed. For example, claim 140 adds the limitation that the antenna be made of an elastic conductive material, and neither reference discloses this feature.

The Office Action includes a rejection under §103(a) based on three references: Little, Horchler and Terry (US 5,820,484). While this rejection referred to claims 136-138, 140-141 and 148-149, the detailed discussion of the rejection focused only on claim 139, and hence Applicant assumes that this rejection is limited to just claim 139. Applicant submits that claim 139 is allowable because it includes the limitations of claim 136 which is allowable over Little and Horchler for the reasons given above, and Terry does not describe the claim limitations, from claim 136, which are missing from both Little and Horchler. Hence claim 139 is allowable.

**Conclusion**

In view of the foregoing, Applicants respectfully submit that the present application is now in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned attorney at (408) 720-8300.

Applicant respectfully requests a one-month extension of time to respond to the pending Office Action. Please charge Deposit Account No. 02-2666 in the amount of \$120.00 for this extension. Furthermore, please charge any shortages and credit any overcharges to our Deposit Account No. 02-2666.

Respectfully submitted,

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